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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/117,795	11/10/98	SADO M	CU-1758RJS

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EXAMINER	
GARRETT, D	
ART UNIT	**PAPER NUMBER**
1774	23

DATE MAILED: 08/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
09/117,795	Sado
Examiner	**Art Unit**
Dawn Garrett	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on 6-18-01 .

2a) ☒ This action is **FINAL.** 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-4 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-4 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

1. This action is in response to the amendment, Paper No. 22, mailed June 18, 2001. Claims 1 and 4 were amended. Claims 1-4 are pending.

2. The text of those sections of Title 35, U.S. Code, not included in this action can be found in the prior Office action, paper no. 20, mailed February 5, 2001.

3. The rejection of claim 4 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, set forth in paragraph 4 of paper no. 20 is withdrawn.

4. The rejection of claim 4 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, set forth in paper no. 20, paragraph 6, is withdrawn due to the amendment of the claim.

5. The rejection of claims 1-4 under 35 U.S.C. 103(a) as obvious over JP 63069897 A is maintained.

6. A copy of the full English translation of JP 63069897 is provided to applicant with this Office action. See attached PTO-892.

7. Claims 2 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 3 recite the preamble limitation "releasing agent" whereas claim

1, upon which claims 2 and 3 depend, now recites "releasing agent composition". There is insufficient antecedent basis for claims 2 and 3. Correction is required.

Response to Arguments

8. Applicant's arguments filed June 18, 2001 have been fully considered but they are not persuasive. The applicant states the Japanese reference describes a composition with 0.2-5.0% of one or more boiling point solvents comprising diethylene glycol monobutyl ether and benzyl alcohol. The examiner notes the amount recited by the JP reference is actually 0.2-50 parts by weight (see page 2 of translation).

Applicant argues the JP reference is directed to an unrelated art. In response, the examiner submits the claims are drawn to "a releasing agent composition", which encompasses the release of any agent from a surface including contaminants from a surface. Furthermore, the intended use of a composition is not patentably significant (see *In re Albertson*, 141 USPQ 730 (CCPA 1964); *In re Heck*, 114 USPQ 161 (CCPA 1957)), and different intended uses for two otherwise similar products is not a basis for a patentable distinction (see *In re Tuominen*, 213 USPQ 89 (CCPA 1982)). Furthermore, "...in apparatus, article, and composition claims, intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim" (see M.P.E.P. § 2111.02, emphasis added).

Applicant further argues that the JP reference discloses a variety of materials from which the compositions might be made. The examiner maintains all the claimed components are disclosed by the JP reference in the claimed amounts. Although the applicant argues no compositions using all three of the instantly claimed components are shown in combination in a single JP reference example, the examiner notes non-preferred embodiments can be indicative of obviousness (see *In re Lamberti*, 192 USPQ 278 (CCPA 1976); *In re Boe*, 148 USPQ 507 (CCPA 1976); *In re Kohler*, 177 USPQ 399 (CCPA 1973)), and a reference is not limited to working examples (see *In re Fracalossi*, 215 USPQ 569 (CCPA 1982)).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Should you have any questions concerning this communication, please direct them to Dawn Garrett at 703-305-0788. The examiner can be reached at this number from 9:00 am to 5:00 pm E.S.T. Monday-Thursday and alternate Fridays. If attempts to reach the examiner by telephone prove unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached at 703-308-0449. Please allow the examiner twenty-four hours to return your call.

A facsimile center has been established for Group 1700 on the 8th floor of Crystal Plaza 3. The hours of operation are Monday through Friday, 8:45 am to 4:45 pm. The fax numbers for Art Unit 1700 are 703-305-3599 for official after-final faxes, and 703-305-5408 for all other

official faxes. Use of the Group 1700 center will facilitate rapid delivery of materials to examiners in Art Unit 1774.

Any inquiry of a general nature, or those relating to the status of this application should be directed to the group receptionist whose telephone number is 703-308-2351.

D. G.
August 15, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700